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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/131,076 08/07/98 KLIGMAN

D 6149-29-U1

000570 HM22/1003  
AKIN GUMP STRAUSS HAUSER & FELD LLP  
ONE COMMERCE SQUARE  
2005 MARKET STREET SUITE 2200  
PHILADELPHIA PA 19103

EXAMINER

TRANS

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

10/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/131,076

Applicant(s)

Kligman et al.

Examiner

Susan Tran

Group Art Unit

1615



☒ Responsive to communication(s) filed on Jul 26, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) 15-19 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-7, 11-14, and 20-22 is/are rejected.

☒ Claim(s) 8-10 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

Receipt is acknowledged of applicants Petition for Extension of Time filed on 11/20/98, Declaration and Fee filed 02/01/99, Petition filed 02/01/99, Request for Corrected Filing Receipt filed 03/22/99, Information Disclosure Statement filed 08/07/98, Request for Extension of Time filed 1/31/00, and Preliminary Amendment A filed 1/31/00, Request for Extension of Time filed 07/26/00, Request for Reconsideration filed 07/26/00, and Supplemental Information Disclosure Statement filed 09/15/00.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1.

Kligman teaches a procedure for treating acne vulgaris that uses salicylic acid (column 1, lines 50-62). The salicylic is dissolve in the aqueous ethanol (column 2, lines 63-68). The solution of salicylic acid applied to the acne lesions is permitted to dry on the skin (column 3, lines 1-5).

The examiner notes that the cited reference is silent in the teaching of the applicant's claimed concentrations of salicylic acid and ethanol. However, it would have been prima facie

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obvious for one of ordinary skill in this art to, by routine experimentation determine a suitable amount of salicylic acid solution in suitable amount of aqueous ethanol to obtain a desirable, predictable, and reliable method for the treatment of dermatological disorders.

2.

Rapaport teaches a method for chemical skin peeling for topical application comprising salicylic acid in acetone (column 14, lines 10-30). The dermatological disorder comprising aging skin, dry skin, photo aged skin, hyperpigmentation, and acne (column 10, lines 14-18).

Absent unexpected results, it would have been prima facie obvious to one of the ordinary skill in the art at the time the claimed invention was made to modify the method of Rapaport by determine a suitable amount of salicylic acid to obtain the claimed invention because the reference teaches the advantageous results accrued in the use of salicylic acid in a cosmetically improved skin composition.

### ***Response to Arguments***

1. Applicant's arguments filed 07/26/00 have been fully considered but they are not persuasive. The examiner maintains the original rejection and thus claims 1-7, 11, 12, 14, and 20-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kligman et al. USPN 4,318,907 ('907); and claims 1-4, 11-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rapaport USPN 5,730,991 ('991).

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2. Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants argue that Kligman ('907) does not teach applicants' claimed concentration of salicylic acid. However, the examiner refers to applicants' generic claim 1, wherein the composition containing at least 15 wt% salicylic acid. Kligman discloses 3-7% salicylic acid (column 2, lines 53-56), which falls far within the claimed concentration.

Applicants argue that Kligman does not disclose the salicylic concentration exceed 7% by weight. However, the examiner relies on the teaching of Kligman in column 7, lines 35-47, wherein the concentration of salicylic acid at 39%, and the treatment was well tolerated.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the low concentrations of acetone cited by Rapaport is unacceptable for use in the present invention) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday to Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600